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EXAMINER

CHANG, JUNGWON

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2154

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/080,484

Applicant(s)

LEWIS, JOHN E.

Examiner

Jungwon Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2 and 4-52 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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FINAL ACTION

1. This Office Action is responsive to amendment filed on 7/11/2005. Claims 1, 2 and 4-52 are presented for examination.

2. The objection to claims 50 and 51 are withdrawn based on amendment filed on 7/11/2005.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 4-11 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sumner et al. (2002/0061003), hereinafter referred to as Sumner, in view of Pimentel et al. (US 2003/0072451), hereinafter Pimentel.

5. As to claim 1, Sumner discloses the invention substantially as claimed, including an apparatus for sending a subscriber of new email messages located at a post office (e-mail server; 450, fig. 4) (page 4, 0042, lines 13-16), comprising:

a wireless proxy email client (messaging gateway; 410, 420; fig. 4; 510, 520, fig. 5) in communication with a wireless network (wireless network, 130, figs. 1, 2) and a post office (e-mail; 450, fig. 4) via an external network (Internet; 215, fig. 2) (page 4, 0041, lines 9-10), the wireless proxy email client utilizing information from a file containing the subscriber's information (subscriber preference/profile; 455, fig. 4) to access the subscriber's email account at the post office at the external network (page 3, 0035; 0037-0038), the wireless proxy email client retrieving a portion of an email message from the subscriber's account (HTTP gateway 410d sends the request to the wireless messaging engine 420 which retrieves the messages from the e-mail server; page 4, 0042) and sending an email to the subscriber (wireless subscriber; 340, figs. 3, 5; 440, fig. 4) (deliver the messages to the subscriber; page 4, 0042, lines 14-16).

6. Sumner discloses a subscriber's email account at the post office (e-mail server 450 serves as an e-mail storage for messages addressed to a particular wireless subscriber; page 4, 0042) that inherently comprises a uniquely identify the email message, i.e., email address, email user's name (communication message includes address information associated with a subscriber; page 2, 0016-0017; wireless network sends the message to the wireless device 140a-140c associated with the e-mail address or alias; page 5, claim 1), as would be understood by one of ordinary skill in the art. Pimentel also discloses uniquely identify the email message (username is the wireless address assigned to the user's device; page 5, 0048; password; page 5, 0050). It would have been obvious to one of ordinary skill in the art at the time the invention

was made to combine the teachings of Sumner and Pimentel because Pimentel's username and password would allow the e-mail server to transmit the e-mail message only to the intended person.

Sumner does not specifically disclose a notification to the subscriber for alerting the subscriber of the email message at the post office. Pimentel also discloses sending a notification to the subscriber for alerting the subscriber of the email message at the post office (wireless gateway formats the notification message into a format recognized by the wireless device, and pushes notification message onto wireless client; ST 106, fig. 6; page 4, 0043; page 3, 0036). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Sumner and Pimentel because Pimentel's alerting subscriber to incoming e-mail messages would allow the subscriber to quickly and conveniently receive new e-mail as soon as the new e-mail arriving at the post office.

7. As to claims 2 and 4, Sumner discloses proxy email client captures the subscriber's user profile comprising the subscriber's password, subscriber login information, and post office information (subscriber profile; 455, fig. 4; profile information that inherently contains login information, passwords, servers information associated with the login data; page 3, [0038]; login information; page 4, [0040]).

8. As to claim 5, Sumner discloses the proxy email client stores the captured user

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profile in the file (page 3, [0035], lines 8-14; [0037]-[0038]).

9. As to claim 6, Sumner discloses the wireless network includes a wireless proxy email server (520, fig. 5) in communication with the proxy email client (510, fig. 5) (page 5, [0051]).

10. As to claim 7, Sumner discloses the wireless proxy server (520, fig. 5) is in communication with a storage device (database; 325, fig. 5).

11. As to claims 8 and 9, Sumner discloses the portion of the email message retrieved from the post office is stored on the storage device (database; 325, figs. 3, 5; page 3, [0037]).

12. As to claims 10 and 11, Sumner discloses wherein the wireless network (130, figs. 1-5) and mobile devices (wireless subscriber unit A-C; 140, figs. 1-2; 340, figs. 3-4; 440, fig. 5) exchange short text message each other (page 1, [0009]; page 4, [0046]). However, Sumner does not specifically disclose SMS message center (Short Message Service Center). Pimentel discloses SMS message center (page 4, 0036-0038). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Sumner and Pimentel because Pimentel's SMS message center because it allows a wireless subscriber to easily send messages to and from the wireless network.

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13. As to claim 14, Sumner discloses the portion of the email message retrieved by the proxy email client is a header portion of the email message (email that inherently comprises a header portion, i.e., "To header", "From header", and a body portion; information source generates a message intended for a particular wireless device; page 2, [0029]).

14. As to claim 15, it is rejected for the same reasons set forth in claim 1. In addition, Sumner discloses the proxy email client (510, 520, fig. 5) sends a message via the external network (Internet; 215, fig. 5) to a paging network (wireless network; 130, fig. 5) for the email message (wireless paging; page 1, [0007], [0009]).

15. As to claim 16, Sumner discloses the external network includes the Internet (215, fig. 2).

16. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sumner, in view of Pimentel, further in view of Skladman et al. (US 6,400,810), hereinafter Skladman.

17. As to claim 17, Sumner and Pimentel do not specifically disclose checking the post office for new email messages at a predetermined periodic rate. However, Skladman discloses checking the post office for new email messages at a predetermined periodic rate (notification server can be configured to poll the e-mail

server at predetermined intervals to check for new e-mail; col. 3, lines 40-42; col. 4, lines 53-56; col. 5, lines 17-20). It would have been obvious to one of ordinary skill in the art at the time the invention was made combine the teachings Sumner, Pimentel and Skladman because Skladman's checking new email at predetermined intervals would allow periodically updating and checking the new email messages.

18. Claims 18-28, 31-33, 35, 36, 40-45 and 47-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sumner, in view of Pimentel and Garakani et al, (US 2002/0064137), hereinafter Garakani.

19. As to claims 18 and 35, Sumner discloses the invention substantially as claimed, including a system for sending a subscriber of new email messages located at a post office (e-mail server; 450, fig. 4) (page 4, 0042, lines 13-16), comprising:

a wireless proxy email client (messaging gateway; 410, 420; fig. 4; 510, 520, fig. 5) in communication with a wireless network (wireless network, 130, figs. 1, 2) and a post office (e-mail; 450, fig. 4) via an external network (Internet; 215, fig. 2) (page 4, 0041, lines 9-10), the wireless proxy email client utilizing information from a file containing the subscriber's information (subscriber preference/profile; 455, fig. 4) to access the subscriber's email account at the post office at the external network (page 3, 0035; 0037-0038), the wireless proxy email client retrieving a portion of a new email message (HTTP gateway 410d sends the request to the wireless messaging engine 420 which retrieves the messages from the e-mail server; page 4, 0042) and sending an

email to the subscriber (wireless subscriber; 340, figs. 3, 5; 440, fig. 4) (deliver the messages to the subscriber; page 4, 0042, lines 14-16).

20. Sumner discloses the wireless proxy email client retrieving a portion of a new email message (HTTP gateway 410d sends the request to the wireless messaging engine 420 which retrieves the messages from the e-mail server; page 4, 0042).

However, Sumner does not specifically disclose wireless proxy email client retrieving new message to determine whether the subscriber has been notified of the new email message previously; alerting the subscriber of the new email message at the post office if the subscriber has not been notified previously about the new email message.

Pimentel discloses wireless proxy email client sending a notification to the subscriber for alerting the subscriber of the new email message at the post office if the subscriber has not been notified previously about the new email message (new email arrives on the enterprise server 48, step 100...prompts an event trigger to send a notification message, indicating a email has been received...wireless gateway formats the notification message into a format and push the notification message onto a wireless device...; page 4, 0043). Pimentel does not specifically disclose determining whether the subscriber has been notified of the message previously. Garakani discloses determining whether the subscriber has been notified of the message previously (determining whether the peer gateway has already notified it; page 4, 0053). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Sumner, Pimentel and Garakani because Pimentel's

notification message and Garakani's determination would allow the client to avoid to receive unnecessary message twice.

21. As to claims 19 and 20, Sumner discloses proxy email client captures the subscriber's user profile comprising the subscriber's password, subscriber login information, and post office information (subscriber profile; 455, fig. 4; profile information that inherently contains login information, passwords, servers information associated with the login data; page 3, [0038]; login information; page 4, [0040]).

22. As to claim 21, Sumner discloses the proxy email client stores the captured user profile in the file (page 3, [0035], lines 8-14; [0037]-[0038]).

23. As to claim 22, Sumner discloses the wireless network includes a wireless proxy email server (520, fig. 5) in communication with the proxy email client (510, fig. 5) (page 5, [0051]).

24. As to claim 23, Sumner discloses the wireless proxy server (520, fig. 5) is in communication with a storage device (database; 325, fig. 5).

25. As to claims 24 and 25, Sumner discloses the portion of the email message retrieved from the post office is stored on the storage device (database; 325, figs. 3, 5; page 3, [0037]).

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26. As to claims 26-28, Sumner discloses wherein the wireless network (130, figs. 1-5) and mobile devices (wireless subscriber unit A-C; 140, figs. 1-2; 340, figs. 3-4; 440, fig. 5) exchange short text message each other (page 1, [0009]; page 4, [0046]).

However, Sumner does not specifically disclose SMS message center (Short Message Service Center). Pimentel discloses SMS message center (page 4, 0036-0038). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Sumner and Pimentel because Pimentel's SMS message center because it allows a wireless subscriber to easily send messages to and from the wireless network.

27. As to claim 31, Sumner discloses the portion of the email message retrieved by the proxy email client is a header portion of the email message (email that inherently comprises a header portion, i.e., "To header", "From header", and a body portion; information source generates a message intended for a particular wireless device; page 2, [0029]).

28. As to claim 32, it is rejected for the same reasons set forth in claim 1. In addition, Sumner discloses the proxy email client (510, 520, fig. 5) sends a message via the external network (Internet; 215, fig. 5) to a paging network (wireless network; 130, fig. 5) for the email message (wireless paging; page 1, [0007], [0009]).

29. As to claim 33, Sumner discloses the external network includes the Internet (215,

fig. 2).

30. As to claim 36, Sumner further discloses sending a wireless email notification (wireless paging is through the use of STMP or e-mail; page 1, [0009]).

31. As to claims 40, 41 and 45, they are rejected for the same reasons set forth in claims 19 and 20 above.

32. As to claim 42, Sumner further discloses storing the captured information in a secure file (authentication; page 2, [0029]).

33. As to claims 43 and 44, Sumner does not specifically disclose checking the post office for new email messages at a predetermined periodic rate. However, Skladman discloses checking the post office for new email messages at a predetermined periodic rate (notification server can be configured to poll the e-mail server at predetermined intervals to check for new e-mail; col. 3, lines 40-42; col. 4, lines 53-56; col. 5, lines 17-20). It would have been obvious to one of ordinary skill in the art at the time the invention was made combine the teachings Sumner and Skladman because Skladman's checking new email at predetermined intervals would allow periodically updating and checking the new email messages.

34. As to claims 47 and 50, Sumner discloses creating a record includes creating a

record comprising a filed including a user identification (email address; page 1, [0009]).

35. As to claim 48, Sumner discloses creating the record including a creating a record comprising a filed including an ISP domain name (email address inherently includes a domain name, i.e., Jungwon.Chang@USPTO.gov, domain name of the address is "USPTO.gov"; email address; page 1, [0009]).

36. As to claim 49, it is rejected for the same reasons set forth in claim 31 above.

37. Claims 34, 51 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sumner, in view of Pimentel and Garakani, further in view of Skladman et al. (US 6,400,810), hereinafter Skladman.

38. As to claim 34, Sumner, Pimentel and Garakani do not specifically disclose checking the post office for new email messages at a predetermined periodic rate. However, Skladman discloses checking the post office for new email messages at a predetermined periodic rate (notification server can be configured to poll the e-mail server at predetermined intervals to check for new e-mail; col. 3, lines 40-42; col. 4, lines 53-56; col. 5, lines 17-20). It would have been obvious to one of ordinary skill in the art at the time the invention was made combine the teachings Sumner, Pimentel, Garakani and Skladman because Skladman's checking new email at predetermined intervals would allow periodically updating and checking the new email messages.

39. As to claims 51 and 52, Sumner, Pimentel and Garakani do not specifically disclose a field including a date on which an email message is received by the post office. However, Skladman discloses a field including a date on which an email message is received by the post office (fig. 5; col. 2, lines 56-63). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Sumner, Pimentel, Garakani and Skladman because Skladman's date on email message would improve the quality of email service by allowing the subscriber to aware of when the email was received.

40. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sumner, Pimentel, further in view of Ng (US 6,640,301).

41. As to claims 12 and 13, Sumner and Pimentel do not specifically disclose computing a checksum on the portion of the email message. However, Ng discloses computing a checksum on the portion of the email message (CKSUM, 34, figs. 5, 14; checksum generator; 40, fig. 12; col. 3, line 63 – col. 4, line 12; col. 4, lines 19-47; col. 7, lines 20-48). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Sumner, Pimentel and Ng because Ng's checksum would improve authentication of e-mail message by delivering the desired e-mail message only to intended recipient using the checksum.

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42. As to claims 29, 30, 37-39 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sumner, Pimentel, Garakani, further in view of Ng (US 6,640,301).

43. As to claims 29, 30, 37-39 and 46, Sumner, Pimentel and Garakani do not specifically disclose computing a checksum on the portion of the email message. However, Ng discloses computing a checksum on the portion of the email message (CKSUM, 34, figs. 5, 14; checksum generator; 40, fig. 12; col. 3, line 63 – col. 4, line 12; col. 4, lines 19-47; col. 7, lines 20-48). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Sumner, Pimentel, Garakani and Ng because Ng's checksum would improve authentication of e-mail message by delivering the desired e-mail message only to intended recipient using the checksum.

44. Applicant's arguments with respect to claims 1, 2 and 4-52 have been considered but are moot in view of the new ground(s) of rejection.

45. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

46. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jungwon Chang whose telephone number is 571-272-3960. The examiner can normally be reached on 9:30-6:00 (Monday-Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JWC
September 30, 2005

A handwritten signature in black ink, appearing to read 'JWC' followed by a stylized flourish.